

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 66

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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CHARLES O. THOMPSON, JESSE F. WILKERSON  
and JAMES A. HENSON

Junior Party,<sup>1</sup>

v.

CHARLES O. THOMPSON

Senior Party.<sup>2</sup>

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Patent Interference No. 103,878

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<sup>1</sup> Application 08/243,630, filed May 16, 1994. Accorded the benefit of U.S. Application 08/051,183, filed April 22, 1993, now U.S. Patent No. 5,329,438, granted July 12, 1994. Assignors to Hubbell, Inc.

<sup>2</sup> Patent 5,329,438, granted July 12, 1994, based on Application 08/051,183, filed April 22, 1993.

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FINAL HEARING: November 30, 1999

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Before CALVERT, PATE and HANLON, *Administrative Patent Judges*.

PATE, *Administrative Patent Judge*.

**FINAL DECISION UNDER 37 CFR § 1.47**

This is a final decision in Interference No. 103,878. Involved are junior party application Serial No. 08/243,630 filed under 37 CFR § 1.47 with inventors Charles O. Thompson, Jesse F. Wilkerson, and James A. Henson, and senior party Patent No. 5,329,438 taken out in the name of Charles O. Thompson as sole inventor. In the Rule 47 application, Thompson is a non-signing co-inventor. The other co-inventors have assigned their interest to Hubbell Incorporated. Thompson retains the ownership of the patent.

The interference subject matter is directed to a streetlight shade or reflector designed to fit the ubiquitous NEMA streetlight head. The reflector is parabolic and extends downwardly past the bulb preventing light directed up into the sky. This configuration ameliorates skyglow and actually

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directs more light to the street below. The count in interference reads as follows:

Count 1

For use in an outdoor pole mounted lighting fixture having a head fixture housing bearing a depending light source, the improvement comprising:

an integral unitary reflector spun from aluminum;

a side member of said reflector forming a light impermeable member of generally parabolic configuration having a circular cross section tapering inwardly toward an open top end containing said light source and directing light from said light source downwardly at a lower open end;

a connection integral with and extending adjacent said open top end of said side member for receiving said light source therein and being complementary to a lower end of said head to prevent the upward passage of light from said light source;

a matt-like finish on an interior surface of said reflector providing uniformity of spread and distribution of light;

said interior surface being of such a configuration as to reflect light generally downwardly with a substantially 90° cutoff at said lower open end of said side member avoiding directing light at an angle above the horizontal;

said bottom of said reflector being entirely open to the atmosphere and devoid of any refractor so that said light is directed generally downwardly entirely by said interior surface of said reflector; and

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a fastener on said reflector adjacent said top end engageable with said head fixture housing for securing said reflector to said head fixture;

whereby loss of light and sky contamination through upwardly directed light is avoided.

The claims of the parties designated as corresponding to the count are:

Thompson et al.:                      Claims 8-14

Thompson:                              Claims 1-7

We note at the outset that both the senior party's brief and the senior party's record were filed late and are the subject of motions<sup>3</sup> under 37 CFR §§ 1.635 and 1.645 for us to accept late papers. These motions are **GRANTED** under our discretion pursuant to 37 CFR § 1.645(b).

Both parties filed records<sup>4</sup> and main briefs. The junior party filed a reply brief. The junior party has also

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<sup>3</sup> Paper Nos. 46 and 54.

<sup>4</sup> In this decision, junior party's record and exhibits will be abbreviated JP followed by the appropriate page number and JX- followed by the appropriate exhibit number, respectively. Likewise, the senior party record and exhibits are abbreviated SP and SX-.

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filed a motion to suppress evidence which was opposed by the senior party. Both parties were represented by counsel at final hearing.

### ***Issues***

The following issues have been raised by the parties in their respective main briefs:

- C        Whether the junior party has established by a preponderance of the evidence that Henson and Wilkerson are joint inventors with Thompson. The junior party lists as an issue whether the senior party has established that Thompson is a sole inventor. However, the senior party has no burden to prove that Thompson is the sole inventor.
  
- C        Whether the claims of the senior party patent and concurrently the claims in the junior party's application are unpatentable over prior art. This issue was first raised by preliminary motion during the preliminary motion period established by the Administrative Patent Judge (APJ). A decision on the motion was deferred to final hearing.

Additionally, the junior party has filed a motion to suppress evidence. We will consider these issues hereinbelow, beginning with the motion to suppress evidence.

### ***Motion to Suppress Evidence***

As we understand the junior party's motion, the junior party is seeking to have its own testimony<sup>5</sup> suppressed to the extent that it is relied upon by the senior party. The reason given for justifying suppression with respect to the cross-examination of the junior party's declarants is that senior party "did not specifically identify the cited portions [of the cross-examination transcripts he was relying upon] or submit copies thereof during the senior party's testimony period." Likewise with respect to the junior party's declarations, as we understand the junior party's motion, the senior party failed to identify during the preliminary motion period what portions of the junior party's declarations he was relying on in opposition to the motion for judgment. Similarly, the junior party further states that the senior party did not, during the senior

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<sup>5</sup> Specifically, the junior party's motion seeks suppression of the junior party's declarations of declarants Wilkerson, Brammer, Myers, Henson, and Milling, and cross-examination deposition testimony of these witnesses at JR36-JR258. This comprises the balance of the junior party's record.

party's testimony period, "cite specific portions [of the junior party's declarations] and/or provide copies of such portions."

The junior party has failed to cite a specific rule for this proposition, although he refers in passing to 37 CFR §§ 1.672(b); 1.682; and 1.688(d). We have looked in vain for such a provision in the rules. We find no requirement that an opposing party submit to the party presenting evidence a description of what portion of the testimony of the party presenting evidence will be used in rebutting that evidence. We note that the junior party has cited no case dealing with this matter. We know of none. We acknowledge that 37 CFR § 1.671(e) requires a party to serve and give notice as to what evidence it is relying on. However, the duty therein does not run to an opponent of the party that is serving and giving notice.

We further note that it is the junior party's own evidence that is sought to be suppressed.<sup>6</sup> We are in

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<sup>6</sup> We note the following sentence from junior party's motion to suppress. "Moreover, the failure to cite specific portions and/or provide copies of such portions improperly  
(continued...)"

agreement with the senior party that the junior party's evidence "may be used by the Senior Party for the purpose of showing that the Junior Party has failed to meet its burden of proof." Accordingly, the motion to suppress, to the extent that it is based on the junior party's so-called general objection, is ***DENIED***.

With regard to the junior party's statement that all objections except as to form were reserved at the deposition, we must remind the parties that objections are to be noted when the deposition is ongoing (37 CFR § 1.675(c); 37 CFR § 1.685(c), and 37 CFR § 1.656(h)) so that the objection can both be recorded and properly responded to by the opponent who may be able to remove the objection by ameliorating the objected to circumstances. Timely objections permit prompt correction of technical errors

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<sup>6</sup>(...continued)  
denied the junior party the opportunity and ability to ***raise any objections to the admissibility of the testimony***" (emphasis supplied). Junior party motion to suppress at 3. We must emphasize that it is the junior party's own testimony being referred to, as relied upon by the senior party. As we understand it, the junior party is stating he was denied the chance to object to his own testimony!



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and minimize delay and inconvenience to the parties and the Board. *See Dreikorn v. Barlow*, 214 USPQ 632, 635 (Comm'r Pats. & Trademarks 1981) and *Larkin v. Kauder*, 202 USPQ 193, 199 (Bd. Pat. Int. 1978). The parties do not have the authority to waive the rule in this regard.

Turning to the specifics of the junior party motion, page JP117, taken individually, and pages JP89-117, taken collectively, as referred to in the senior party's brief are a proper part of the junior party's record and cannot be suppressed simply because the senior party cites to the record to show that the junior party has failed to make out a case.

The request to suppress JP228-29 because it ostensibly assumes facts not in evidence is unsupportable on its face. The Milling declaration identifies Thompson and states that Milling had been to Thompson's place of business. It is difficult to see how it can be argued that there is no foundation for a question in cross-examination about how long Milling has known Thompson.

As to JP251-52, the testimony here is concerned with Henson not Thompson, and the arguments in the motion to

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suppress are simply irrelevant for this reason. As to JP179, cited by the junior party as calling for speculation, it is undenied, by any witness, that Thompson had Henson and Milling over to his office to discuss a reflector and whether Henson could supply such a reflector. Thus, it does not require speculation on Henson's part to have been asked what Henson understood Thompson to be asking for. Suppression on this ground is **DENIED**. Likewise, Milling's testimony at JP246-49 will not be suppressed for the same reason.

However, with respect to pages JP182-83, concerning patentability and the GE publication, the junior party argument that the questions are beyond the scope of direct, i.e., the original Henson declaration, is well taken. The testimony on these pages relating to the publication will be suppressed. The motion is **GRANTED** to this extent.

The question about Henson knowing if Thompson had talked to a competitor (JP194) is not hearsay and is not seen as irrelevant. Suppression on these grounds is not warranted. The testimony (JP200-01, JP210-11) regarding people who

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"marveled" will not be suppressed. Henson's declaration contains evidence relating to night testing of the prototype. Thus, testimony on his reaction to the test is fair game in cross-examination. Such testimony does not violate 37 CFR § 1.639 as argued by the junior party, since senior party has the right to cross-examine all junior party's declarants if junior party intends to rely on their testimony at final hearing. See 37 CFR § 1.671(e) and 37 CFR § 1.672(d). The senior party, in this instance, is permitted to cross-examine the junior party's witnesses on the patentability issue, because the junior party introduced these declarations into evidence during the testimony period. Thus, JP64-65, 43, 44, and JP82-85 will not be suppressed.

Finally, the Henson notation on the facsimile does not properly raise a suppression issue, inasmuch as Henson and Brammer both reference a facsimile in their declaration. Thus, testimony concerning the facsimile is proper on cross-examination.

To sum up, we have considered the junior party's motion for suppression of evidence, and will suppress pages JP182-83 as beyond the scope of direct. To this extent the

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motion is granted. With respect to all other requests for suppression of evidence, the motion is denied. The junior party's motion to suppress evidence is **GRANTED-IN-PART**.

***Originality***

"Determining 'inventorship' is nothing more than determining who conceived the subject matter at issue, whether that subject matter is recited in a claim in an application or in a count in an interference. Conception, and consequently inventorship, are questions of law." ***Sewall v. Walters***, 21 F.3d 411, 415, 30 USPQ2d 1356, 1358 (Fed. Cir. 1994)(quoting ***Hybritech Inc. v. Monoclonal Antibodies, Inc.***, 802 F.2d 1367, 1376, 231 USPQ 81, 87 (Fed. Cir. 1986), ***cert. denied***, 480 U.S. 947 (1987)).

This case, therefore, comes to us in the context of an originality contest as opposed to a priority contest. ***Sewell***,

21 F.3d at 415, 30 USPQ2d at 1358 (quoting ***Applegate v. Scherer***, 332 F.2d 571, 573 n.1, 141 USPQ 796, 798 n.1 (CCPA 1964)("[I]n an originality case the issue is not who is the first or prior inventor, but who made the invention.")). The

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"inventorship" issue to be decided is thus merely who conceived the invention for which patent protection is sought, and not who first conceived that invention. **Sewell**, 21 F.3d at 415, 30 USPQ2d at 1358.

As the junior party in an interference between co-pending applications, junior party Thompson et al. bears the burden of proving priority or, in this case inventorship, by a preponderance of the evidence. **See Cooper v. Goldfarb**, 154 F.3d 1321, 1326, 47 USPQ2d 1896, 1900 (Fed. Cir. 1998)(**quoting Scott v. Finney**, 34 F.3d 1058, 1061, 32 USPQ2d 1115, 1117 (Fed. Cir. 1994)).

Conception has been defined as the formation, in the mind of the inventor, of a definite and permanent idea of the complete and operative invention. **Coleman v. Dines**, 754 F.2d 353, 359, 224 USPQ 857, 862 (Fed. Cir. 1985)(**quoting Gunter v. Stream**, 573 F.2d 77, 80, 197 USPQ 482, 484 (CCPA 1978)). It is settled that in establishing conception a party must show every feature recited in the count, and that every limitation in the count must have been known at the time of the alleged conception. **Coleman**, 754 F.2d at 359, 224 USPQ at 862.

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Conception is complete when one of ordinary skill in the art could construct the apparatus without unduly extensive research or experimentation. **Sewell**, 21 F.3d at 416, 30 USPQ2d at 1359. **See Summers v. Vogel**, 332 F.2d 810, 816, 141 USPQ 816, 821 (CCPA 1964); **In re Tansel**, 253 F.2d 241, 243, 117 USPQ 188, 189 (CCPA 1958).

Neither conception nor reduction to practice may be established by the uncorroborated testimony of the inventor. **See Tomecek v. Stimpson**, 513 F.2d 614, 619, 185 USPQ 235, 239 (CCPA 1975). The inventor's testimony, standing alone, is insufficient to prove conception--some form of corroboration must be shown. **See Price v. Symsek**, 988 F.2d 1187, 1194, 26 USPQ2d 1031, 1036 (Fed. Cir. 1993). While the "rule of reason" originally developed with respect to reduction to practice has been extended to the corroboration required for proof of conception, the rule does not dispense with the requirement of some evidence of independent corroboration. **See Coleman**, 754 F.2d at 360, 224 USPQ at 862. As the CCPA stated in **Reese**

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**v. Hurst**, 661 F.2d 1222, 1225, 211 USPQ 936, 940 (CCPA 1981):

"[the]

adoption of the 'rule of reason' has not altered the requirement that evidence of corroboration must not depend solely on the inventor himself." There must be evidence independent from the inventor corroborating the conception.

Additionally, we acknowledge that there is no single formula that must be followed in proving corroboration. An evaluation of all pertinent evidence must be made so that a sound determination of the credibility of the inventor's story may be reached. **Price**, 988 F.2d at 1195, 26 USPQ2d at 1037.

Independent corroboration may consist of testimony of a witness, other than the inventor, to the actual reduction to practice or it may consist of evidence of surrounding facts and circumstances independent of information received from the inventor. **Reese**, 661 F.2d at 1125, 211 USPQ at 940. **See also, for conception**, Rivise and Caesar, **Interference Law and Practice**, Vol. I, § 126

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and Vol. III, § 542 (Michie Co. 1947) **and for reduction to practice**, Vol. III §§ 543 and 544.

***Senior Party's Originality Case***

While no one has seriously challenged the fact that the senior party has contributed to the conception of the invention, and is at least a co-inventor, senior party has sought to show a full and completely independent conception of the invention

prior to the meeting of Thompson with Henson and Milling on February 17, 1993, which would establish that Thompson is a sole inventor.<sup>7</sup> For proof of this conception, the senior party is relying on a facsimile transmission from Thompson to Yarborough at South Carolina Electric and Gas on January 26, 1993. However, Thompson was the senior party's only witness. Yarborough did not testify. This raises an issue of corroboration with regard to the facsimile, SX-1. At oral hearing, senior party's counsel argued that the facsimile

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<sup>7</sup> See senior party brief footnote 1.



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provided its own corroboration, inasmuch as it was evidence of what was conceived, since it showed a sketch of the invention.

However, if a party places reliance on an embodiment of the invention in some physical form, such as a sketch or drawing, for proof of conception, the existence of the embodiment at the time must be established by testimony of a person other than the inventor. ***Moran v. Paskert***, 205 USPQ 356, 359 (Bd. Pat. Int. 1979). ***Accord Price***, 988 F.2d at 1196, 26 USPQ2d at 1037-38 (testimony of secretary that she recalled seeing drawing as of critical date provides necessary evidence corroborating testimony of inventor as to date of conception). Therefore,

we are constrained to hold that the senior party exhibit 1 is uncorroborated and can provide no support for a senior party conception prior to the meeting with Henson and Milling.

#### ***Junior Party's Originality Case***

The junior party's claim for inventorship is based on the following facts. In February 1993, James A. Henson, a manufacturer's representative for Hubbell, and his assistant,

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Patricia Milling, met with senior party Thompson at Thompson's place of business. JP27; JP32; JP173. At the meeting, Thompson described a lighting fixture that he hoped Henson's manufacturer could provide. According to Henson and Milling, the fixture was only generally described and no drawing of the desired fixture

was shown to them by Thompson. JP27; JP32. It is their further testimony that Thompson did not describe the material or finish of the desired reflector to them. JP27; JP32.

Henson testified that upon return to his office, he produced two drawings of a lighting fixture by cutting and pasting stock lighting parts from catalogs of Hubbell products. JP28. On cross-examination, Henson stated that he personally came up with the idea of mounting or combining the two existing products together. "I thumbed through the catalog and I found this reflector. . . ." JP179. "So I mated the two together,

pasted it up and sent that to George Brammer." JP179. "What I did was mate an existing product with an existing product. . . ." JP186.

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Henson's testimony diverges with respect to Milling's on this point, however. In cross-examination, Milling undoubtedly claimed to have come up with the idea of using a high bay reflector on the NEMA head by herself. When speaking of what she called the skycap, she was asked, "Did you design it?" Answer: "Yes, sir." JP231. And at JP234, Milling stated:

Well, I mentioned to Jim about, Let's check and see if this would work before we did this. I mean, I had thought about it in the morning and when I got to the office, I said, Hey, look at this, because I didn't know if it would work or not, and he's been in that business longer than I.

What Milling is describing is clearly the mental part of inventing. Her testimony, while uncorroborated, is closer to a conception than any act by either Henson or Wilkerson.

Furthermore, in our view, it is not possible for Brammer or Wilkerson, who received the facsimile from Henson with a drawing of the invention, to corroborate any conception by Henson. They can only state the contents of the facsimile they received and who they received the facsimile from. JP17; JP21.

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We acknowledge that the junior party has argued that Milling's testimony is ambiguous, for in some instances her testimony could possibly be interpreted to refer to both Henson and Milling working together. In this regard, we merely note that ambiguous testimony, whether from a putative inventor or a putative corroborator, does not militate for establishing a conception by a preponderance of the evidence. Ambiguous testimony from Milling cuts against any legal conclusion that Henson was an inventor. Due to this lack of corroboration, it is our conclusion that the junior party has not established that Henson is a co-inventor.

With respect to Wilkerson, it is our finding that Wilkerson was outdoor products manager at Hubbell. JP41. When Brammer received the facsimile drawing from Henson, he referred it to Wilkerson. JP41. Wilkerson stated that his contributions to the invention were finding a reflector head with the correct parabolic shape, moving the latches to fit the standard NEMA head, and specifying a diffuse finish to give a uniform spread of light. JP51-52.

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As to Wilkerson's contribution, this was not an elaborate program of research, experimentation, or design of parts, which would be necessary to consider him as a co-inventor, but merely the selection of the size and shape of certain parts, i.e., the proper high bay reflector and the location of NEMA

toggle latches on the stock spun aluminum reflector which already had the correct surface finish. We see it as simply the exercise of the normal skill expected of an ordinary lighting designer, which would not have involved any inventive acts on the part of Wilkerson. The necessity of a certain amount of selection of sizes of parts, materials, etc., along predetermined lines does not indicate contribution to the conception of an invention. **See Bac v. Loomis**, 252 F.2d 571, 577, 117 USPQ 29, 34 (CCPA 1958)(Loran patent case); **Fredkin v. Irasek**, 397 F.2d 342, 158 USPQ 280 (CCPA), **cert. denied**, 393 U.S. 980 (1968) and **Sewell**, 21 F.3d at 415, 30 USPQ2d at 1358.

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Based on the underlying facts as recited above, it is our legal conclusion that neither Henson nor Wilkerson has been established as a co-inventor with Thompson by a preponderance of the evidence. Accordingly, judgment will be entered against the junior party on the ground of lack of originality at the conclusion of this decision.

***Junior party Thompson et al.'s Motion for Judgment***

During a preliminary motion period established by the APJ, junior party Thompson et al. filed a motion<sup>8</sup> under 37 CFR

§ 1.633(a) for judgment that claims 1-7 (all claims) of the senior party's involved patent were unpatentable. In a decision mailed January 22, 1998,<sup>9</sup> the APJ deferred decision of the motion to final hearing.

The motion alleged that all claims of the senior party patent designated as corresponding to the count were unpatentable under 35 U.S.C. § 102 and/or § 103. The motion

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<sup>8</sup> Paper No. 9.

<sup>9</sup> Paper No. 19.

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was supported by declarations from Messrs. Wilkerson and Kenyon and documentary exhibits of prior art. The motion was opposed by the senior party.

The following represents our findings of fact with respect to the prior art exhibits filed in support of the motion.

Exhibit 1 is a promotional or catalog page from General Electric describing Novalux street lighting fixtures. It was discovered in the files at Hubbell. It bears a printed date of November 4, 1944. The figure in the lower right-hand corner illustrates a fixture for use on an outdoor pole having a head fixture containing a socket for a depending light source. Depending from the head fixture is a unitary reflector formed from light impermeable material. The reflector is of generally

parabolic configuration and is apparently of circular cross section and tapers inwardly to a top. The bulb filament is generally located at the focus of the parabolic reflector. The reflector appears to have an inwardly directed flange

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which mates with a complementary flange on the head. No light can escape from the lamp in an upward direction. The reflector is formed of aluminum with a finish on the reflector of natural, unpainted aluminum. The interior of the reflector is of such a configuration that light is reflected downwardly to the open end of the reflector member with a substantially 90° cutoff. The reflector has toggle latches to mount the reflector to the head. Wilkerson and Kenyon both state that the Alzak finish the General Electric exhibit discloses is a matte finish. JP8; JP13.

The luminaire of the General Electric publication differs from the claimed subject matter of the senior party patent in that the reflector is not entirely open to the atmosphere, since a clear glass diffuser is mounted to the lower, open end of the reflector. Also, as required by claims 3 and 4 of the senior party's involved patent, the General Electric reference is silent with respect to being spun from the disclosed aluminum material.



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Documentary Exhibit 3 is several pages from the Hubbell Commercial/Industrial Buyers Guide bearing a printed date of April 26, 1990. Page 202 describes Industrial Highbay light fixtures. These fixtures are supplied in both enclosed and open designs. While the enclosed fixture has a clear glass element permanently spun on the reflector, the open unit is entirely open to the atmosphere as claimed in the senior party's involved patent claims. The reflector of the highbay fixture is unitary and spun from aluminum with a matte finish. It has the claimed parabolic shape and provides the claimed 90° cutoff at a horizontal plane. Finally, the highbay reflector has latches to hold the reflector to the fixture head.

The highbay fixture of Exhibit 3 merely differs from the senior party patent's claimed subject matter in that the open highbay is not certified for outdoor or wet locations, and while the highbay is disclosed as mounted from a depending nipple, there is no disclosure of mounting the structure on a pole.

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Exhibit 5 is several pages from the IES Lighting Hand- book. These pages bear a printed date of 1947. On page M-178, two streetlight fixtures are described. The second fixture,

OV-18, is a Luminaire with a universal metal head and a metal reflector having a parabolic contour with a metal skirt. The

bottom of the lamp filament is approximately  $\frac{1}{8}$  of an inch above the skirt which is described as giving a cutoff of ***substantially 90°***, viz., an absolute cutoff of 85°. The design is acknowledged to provide more light "up and down the street" with reduced glare. By locating the lamp up in the reflector, the lamp is "given added protection from outside forces."

Exhibit 5 differs from the senior party's claimed subject matter in that it is not stated that the reflector is made of spun aluminum with a matte finish. We note that, while Exhibit 5 has a flange or skirt at the bottom of its parabolic contour, such is not precluded by the senior party's claims. No latches are expressly shown by Exhibit 5.

Finally, Exhibit 7 accompanying the motion is the senior party patent. In the senior party patent application, senior party has illustrated the prior art NEMA Head fixture in figure 1 and at col. 2, line 63, to col.3, line 12. The prior art is described thusly:

The prior art is illustrated in FIG. 1 as including a two part refractor including an upper bowl-like portion 10 which is formed from spun aluminum. An upper end of the bowl-like member 11 receiving a standard NEMA Head fixture including a housing 12 which carries a photo control device 13. An arm illustrated in broken lines at 14 is received within the laterally extending hollow bracket 15 in which it is clampingly engaged by

securement of the bolts 16 and 17. Opposed fixed clamping members 18 in the form of latching ears are carried adjacent a lower edge of the housing 12 for receiving spring biased clamps, not shown. A lamp is illustrated at 19 and is received within the refractor 20 which forms a lower half of the standard lighting fixture. The refractor includes prisms which are designed to direct light downwardly into the side, but such refractor allows considerable glare and considerable light to escape causing light contamination of the night sky.

In our view, the subject matter of all of the senior party's patent claims would have been obvious to one of

ordinary skill in view of the combined teachings from the above-described prior art. It is our view, for example, that it would have been obvious to eliminate the glass refractor and extend the parabolic shade of the NEMA head, described as prior art in the senior party's patent, in view of the teaching of the IES disclosure that a shade extending past the lamp provides the desirable "absolute cutoff," provides more light "up and down the street," and further serves to protect the lamp from outside forces. These teachings from the IES disclosure provide ample express motivation or suggestion for such a modification.

By the same token, the disclosure of the Hubbell Highbay fixture and the IES OV-18 Luminaire are evidence of a recognition in the art that in some circumstances a glass refractor or diffuser on the bottom of a metallic reflector is not desirable, i.e., when a horizontal light cutoff is desired both to provide greater downlight and to reduce glare. Accordingly, following this recognized art teaching, it would have been obvious to one of ordinary skill to dispense with the glass refractor of the GE luminaire or to extend the

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reflector and dispense with the refractor on the prior art NEMA head disclosed in the senior party's patent.

We also acknowledge the declarations of Messrs. Wilkerson and Kenyon. Inasmuch as we have compared the closest prior art to the senior party's patent claims and found no prior art reference to be anticipatory, we do not credit the declarations to the extent that they are directed to the motion's allegation that the subject matter of the senior party claims are anticipated. With respect to Wilkerson's statements in the declaration that the Highbay fixture had been pole mounted outdoors, the statement was retracted as "probably wrong" in cross-examination. JR65. With respect to Kenyon's testimony, Kenyon only knew of one instance where a Highbay-type fixture was used outdoors. Kenyon stated that this type of fixture had been suspended from overhead wires or catenaries in a rail yard. JP82. However, it seems clear, from the Hubbell catalog page

exhibit, that only the enclosed embodiment is recommended for wet locations, and the enclosed embodiment has a glass lens

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permanently spun on the reflector. This use would appear not to satisfy the patent's open at the bottom claim limitation, and would therefore not have been anticipatory.

Additionally, with respect to Kenyon's testimony, rarely has unsupported oral testimony been considered sufficient to prove prior knowledge or use, and it must always be subjected to close scrutiny. **See Carella v. Starlight Archery**, 804 F.2d 135, 138, 231 USPQ 644, 646 (Fed. Cir. 1986). As the Court of Claims stated in **Lockheed Aircraft v. United States**, 553 F.2d 69, 75, 193 USPQ 449, 454 (Ct. Cl. 1977):

Indeed, the oral testimony of witnesses, speaking only from memory in regard to past transactions has, in the absence of contemporaneous documentary or physical evidence, consistently been found to be of little probative value. . . . Such uncorroborated testimony is insufficient to show anticipation, within the meaning of 35 U.S.C. § 102, of an issued patent.

**See also Eibel Process Co. v. Minn. & Ontario Paper Co.**, 261 U.S. 45, 60 (1923)(oral evidence falls far short of overcoming the presumption of patent novelty) and **Wasburn & Moen Mfg. Co. v. Beat 'em All Barbed-Wire Co.**, 143 U.S. 275, 284-

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285 (1892)(contentions regarding certain unpatented devices  
the

existence of which are only proven by oral testimony are  
subjected to the closest scrutiny). **But see Thomson S.A. v.  
Quixote Corp.**, 166 F.3d 1172, 49 USPQ2d 1530 (Fed. Cir.),  
**cert. denied**, 119 S.Ct. 2395 (1999). Accordingly, Kenyon's  
testimony as to a prior use is entitled to but little weight.

Turning to the declarations' discussions of the  
obviousness of the senior party's claims, we merely point out  
that "an expert's opinion on the legal conclusion of  
obviousness is neither necessary nor controlling." **Avia Group  
Int'l, Inc. v. L. A. Gear Cal., Inc.**, 853 F.2d 1557, 1564, 7  
USPQ2d 1548, 1554 (Fed. Cir. 1988). The question of  
patentability is a matter of law which we must decide. **See In  
re Vamco Machine and Tool Co.**, 752 F.2d 1564, 224 USPQ 617  
(Fed. Cir. 1985).

We find no merit in the junior party's contention  
that the affidavits conclusively establish that their  
invention would have been obvious to a person of ordinary

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skill in the art under 35 U.S.C. § 103. "That is the ultimate legal question which the court must decide. So far as the affidavits undertake to tell the court the answer to that question, they are but incompetent expressions of opinion.

***See In re Chilowsky***, 306 F.2d 908, 50 CCPA 806." ***In re Weber***, 341 F.2d 143, 145, 144 USPQ 495, 497 (CCPA 1965). Other assertions in the affidavits are at best no more than evidence to be evaluated along with the other evidence of record, including the prior art. ***Id.***

#### ***Objective Evidence of Non-Obviousness***

Included in the senior party's brief are arguments directed to the so-called secondary considerations, also referred to as objective evidence of non-obviousness. When such evidence is presented, it is our duty to consider all evidence anew. ***See, for example, In re Eli Lilly & Co.***, 902 F.2d 943, 945, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990). We are also mindful that objective evidence of nonobviousness in any given case may be entitled to more or less weight depending on its nature and its



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relationship with the merits of the invention. **See *Stratoflex Inc. v. Aeroquip Corp.***, 713 F.2d 1530, 1539, 218 USPQ 871, 879 (Fed. Cir. 1983).

The senior party references the junior party's exhibit A, JX-A, the facsimile from Henson to Brammer, which includes Henson's handwritten notation, "If we can make this - - I can sell thousands of them--call me--Jim H." The senior party argues that this is some sort of evidence of the popularity of the subject matter of the senior party's claims. In our view, this statement by Henson on the facsimile provides little evidence regarding long-felt need, commercial success or recognition by the public.

Most importantly, the statement is prospective in nature. It is merely an anecdotal prediction by Henson. We must emphasize that the senior party has provided no evidence that thousands of the reflectors have actually been sold. The senior party has also failed to provide any evidence regarding the nexus between the claimed invention and any sales. The

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junior party exhibit A provides little evidence of long-felt need, commercial success or recognition by the public.

The senior party also refers to the testimony of Henson at JR200-01, wherein Henson stated that in the spring of 1993 representatives from both South Carolina Electric & Gas and Carolina Power & Light, along with Thompson, Milling, and Henson visited the test site where the prototype reflector had been installed. Henson stated: "That night after dinner we all went out and visited and marveled at it." JR201. Without more information, it is impossible to credit this statement of Henson as evidence of long-felt need, commercial success or recognition by the public. Henson is never questioned about what feature he marveled at. The statement is so vague that it is impossible to determine what property of the fixture or reflector is being noted. Therefore, it is impossible to ascertain whether a nexus between the invention and the lauded property or feature of the

reflector exists. In short, the statement that Henson and other unknown persons marveled at the invention is too vague

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and the report of this "marveling" too fragmentary to afford any evidence weighing for the unobviousness of the invention.

Having considered all the evidence anew, and carefully weighing the evidence both for and against obviousness, it is our conclusion that the subject matter of all of senior party's patent claims would have been obvious at the time the invention was made to one of ordinary skill in the outdoor lighting art. The junior party's motion for judgment is **GRANTED**. Accordingly, we will enter judgment against the senior party on the ground of unpatentability, hereinbelow.

Additionally, we note that the prior art discussed, supra, and the declarations from the junior party's declarants clearly establish the unpatentability of the junior party's claimed subject matter. The junior party has made of record no evidence to the contrary, and has included no argument in his main brief that his claims are patentable over this prior art. Accordingly, judgment will also be entered against all claims of the junior party on the ground of unpatentability under 35 U.S.C. § 103, hereinbelow.

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### Judgment

Judgment in Interference No. 103,878 is entered against Charles O. Thompson, Jesse F. Wilkerson, and James A. Henson, the junior party, on the grounds of unpatentability and originality. Charles O. Thompson, Jesse F. Wilkerson, and James A. Henson are not entitled to a patent containing claims 8-14, which claims correspond to the count in interference. Judgment is also entered against Charles O. Thompson, the senior party, on the ground of unpatentability. Charles O. Thompson is not entitled to his patent claims 1-7, which claims correspond to the count in interference.

	IAN A. CALVERT	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	BOARD OF
PATENT		)	
	WILLIAM F. PATE, III	)	APPEALS AND

Interference No. 103,878

INTERFERENCES	Administrative Patent Judge	)
		)
		)
		)
	ADRIENE LEPIANE HANLON	)
	Administrative Patent Judge	)

WFP:psb

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